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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Paul C. Blank

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

10/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/804,953	Applicant(s) BLANK ET AL.	
	Examiner Patricia L. Nordmeyer	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Reopening of Prosecution

1. In view of the Remand filed on August 29, 2008, PROSECUTION IS HEREBY REOPENED. New grounds are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing at the end of the office action.

Withdrawn Rejections

2. Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (USPN 5,578,352) in view of Slagsvol (USPN 4,884,826) and Lane (USPN 2,170,147).

Smith discloses a label roll (Column 1, lines 40 – 43) comprising web (Column 2, lines 54 – 58) that is continuous along said running axis and imperforate (Column 3, lines 6 and 7) having a front surface and an opposite back surface wound longitudinally along a running axis (Figure 2, #13 and 14) in a roll (Column 1, lines 40 – 43), said back surface including a plurality of non continuous adhesive patches (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46) aligned in a column along a running axis of said web in a minor area of said back surface with the remaining area of said back surface being devoid of adhesive (Figure 2, #34 and 35; Column 4, lines 16 – 18) and including adhesive-free spaces transversely bridging said web longitudinally between said adhesive patches to isolate said patches in sequential labels and permit cutting of said web in said adhesive-free spaces to separate said labels (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46, whereby the adhesive-free areas are formed in between the discontinuous strips) and said front surface including a release strip extending along said running axis behind said column of adhesive patches and laminated to said patches in

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successive layers in said roll (Column 3, lines 42 – 52) with said patches being sized for bonding an individual label to a surface (Figure 3, #11) in claims 1, 3, 19 and 31. With regard to claims 4 – 7, 23 and 24, the patches are aligned along said and edge of said web (Figure 2, #34 and 35), have straight edges aligned parallel and transversely with said running axis forming a rectangular shaped area (Figure 3) and are elongate along said running axis (Figure 2 and 3). The web further includes corresponding index marks between adjacent patches to define corresponding labels (Figure 3, #19) as in claims 8, 15, 21 and 25. With regard to claims 17, 18, 22 and 29, the release strip is narrow to conform in width with said column of adhesive patches thereby leaving the remainder of the web front side devoid (Column 3, lines 48 – 42) and is made from a silicone coating (Column 3, line 33). As in claim 28, each of said labels has a plurality of said adhesive patches (Figure 2, #34 and 35). However, Smith fails to disclose the patches being isolated on one side only of the transverse middle, being aligned on one lateral edge of the web and closer thereto than an opposite edge of said web, the patches have arcuate edges extending transversely with said running axis, convex leading edges with convex trailing edges connected by straight edges, ovals with major axes disposed parallel to the running axis, the patches being elongate transverse to said running axis, devoid of index marks and the release strip covering said web front side in full.

Slagsvol teach disclose the patches being isolated on one side only of the transverse middle (Figure 6, #2f; Column 2, lines 45 – 48), being aligned on one lateral edge of the web and closer thereto than an opposite edge of said web (Figure 6, #2f; Column 2, lines 45 – 48) for the

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purpose of forming a paper that is easily and rapidly applied to a surface (Column 1, lines 43 – 44).

Lane teaches the patches of adhesive (Figure 1, #11; Page 2, Column 1, lines 33 – 38) being isolated on one side only of the transverse middle (Figure 9, #11) or being aligned on one lateral edge of the web and closer thereto than an opposite edge of said web (Figure 9, #11), the release strip covering said web front in full (Page 2, Column 1, lines 44 – 51) and devoid of index marks (Figure 1) for the purpose of being able to cut each band from a coated sheet without gumming the cutting knife and with fusing together the edges of the resulting bands (Page 3, Column 1, lines 15 – 20).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a single adhesive patch isolated on one side only of the transverse middle, no index marks and a release strip covering said web front in full in Smith in order to form a paper that is easily and rapidly applied to a surface as taught by Slagsvol and to cut each band from a coated sheet without gumming the cutting knife and with fusing together the edges of the resulting bands as taught by Lane.

Regarding the patches having arcuate edges extending transversely with said running axis, convex leading edges with convex trailing edges connected by straight edges, ovals with major axes disposed parallel to the running axis, it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape

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provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947), *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the adhesive patch as Smith teaches a variety of shapes being used (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46).

With regard to the limitations of “for use in a printer having a cutting blade” and “permit transverse cutting of said web said blade” in claim 19, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The language of the claim is directed towards the structure of the label roll and not how the label roll is being used in combination with the printer or the cutting blade.

With regard to the limitations of “said printer includes an index sensor ” and “datable by said sensor” in claim 25, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The language of the claim is directed

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towards the structure of the label roll and not how the label roll is being used in combination with the printer that includes a index sensor.

Response to Arguments

5. Applicant's arguments with respect to claims 1 – 29 and 31 have been considered but are moot in view of the new ground(s) of rejection. However, since the same prior art is being used above, the arguments will be responded to below.

In response to Applicant's argument that Slagsvol is nonanalogous art relation neither to Applicants' field of endeavor or specific problems, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a label, as defined by www.webster.com, is "a slip (as of paper or cloth) inscribed and affixed to something for identification or description". A label, as defined by www.dictionary.com, is "a slip of paper, cloth, or other material, marked or inscribed, for attachment to something to indicate its manufacturer, nature, ownership, destination, etc". Slagsvol becomes a label the moment a mark is made on the surface of tracing paper and the paper is stuck to the surface of an object and a mark is made on the surface of the binding strip and the paper is adhered to the surface of an object, respectively. Therefore, Slagsvol is not considered non-analogous art based on the definition of a label as they are pertinent to the

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particular problem with which the applicant was concerned, the placement of adhesive on the pack surface of a web.

In response to Applicant's argument that the tracing paper in Slagsvol is tracing paper and is not characterized or used as any label relevant to the industry, as defined by www.webster.com, is "a slip (as of paper or cloth) inscribed and affixed to something for identification or description". A label, as defined by www.dictionary.com, is "a slip of paper, cloth, or other material, marked or inscribed, for attachment to something to indicate its manufacturer, nature, ownership, destination, etc". Slagsvol becomes a label the moment a mark is made on the surface of tracing paper and the paper is stuck to the surface of an object and a mark is made on the surface of the binding strip and the paper is adhered to the surface of an object, respectively.

In response to Applicant's argument that the Examiner fails to present a prima facie case of obviousness for Slagsvol or for the combination of Smith and Slagsvol as there are no labels in Slagsvol, a label, as defined by www.webster.com, is "a slip (as of paper or cloth) inscribed and affixed to something for identification or description". Slagsvol becomes a label the moment a mark is made on the surface of the binding strip and the paper is adhered to the surface of an object, respectively. Therefore, Slagsvol is not considered non-analogous art based on the definition of a label. As for the Examiner failing to explain how to modify the label roll in Smith, Smith discloses that it is known to have adhesive in the form of discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46) in a roll. It would

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have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have a label with different adhesive shapes as taught by the combination of Slagsvol and Smith.

In response to Applicant's argument that Smith appears to teach away different length adhesive-free zones in each label, the elongate patches along the running axis, the elongate transverse patches along the running axis, the arcuate edge species of the patches, the convex leading and trailing edge species of the patches, the oval species of the adhesive patches, whereas Smith would clearly teach uniform or equal length patterns of adhesive and silicone for uniform and sufficient bond strength in the label, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement "Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28". Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern, which would result in a change of length of the adhesive free zones in the label.

In response to Applicant's argument that the Examiner is using hindsight to combine the references to construct the Applicant's invention, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). A label, as defined by www.webster.com, is “a slip (as of paper or cloth) inscribed and affixed to something for identification or description”. Smith and Slagsvol all teach that it is known to use a variety of shapes of adhesive in combination with a web to form a label.

In response to Applicant's argument that the combination of Smith and Slagsvol fail to disclose the column of patches aligned closer to one edge than the other, Slagsvol teaches that it is known to have adhesive patches on both edges of a substrate (Figure 5) or just on a single side (Figure 6). Therefore, it would have been obvious to one of ordinary skill in the art to place an adhesive only on one side of the substrate for the purpose of controlling the adherence of the substrate to a surface. Also, please see the newly presented rejection of Smith, Slagsvol and Lane above.

In response to Applicant's argument that Slagsvol and Smith both fail to disclose the imperforate web, Smith discloses a label roll (Column 1, lines 40 – 43) comprising web (Column 2, lines 54 – 58) that is continuous along said running axis and imperforate (Column 3, lines 6 and 7).

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In response to Applicant's argument that Smith fails to disclose the straight edges parallel to the running axis in the specification for specific benefit, the transverse straight edges of the patches and correspondingly disclosed in the specification for specific benefit, the rectangular patches and correspondingly disclosed in the specification for specific benefit, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). The shapes of the adhesive is described using the same description of the silicone patterns in the specification of the prior art of Smith as shown by the statement "Also, while continuous strips 34, 35 are desired, other patterns can be applied in the same as indicated for the silicone patterns 27, 28". Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

In response to Applicant's argument that that Smith fails to disclose cooperation between the registration marks and the adhesive free zones, the claims state that web has a series of index marks spaced longitudinally there along to define a series of labels. The language of the claim states nothing with regard to the adhesive free zones and the index marks cooperating together as the claim does not give a specific placement of the index marks in correlation to the adhesive free zones.

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In response to Applicant's argument that Smith fails a plurality of the patches in the label, Smith clearly states that the adhesive may have patterns or be applied in a continuous strip (Column 3, line 66 to Column 4, line 6). The pattern of adhesive varies as it does for the silicone patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have multiple adhesive patches, since it has been held that mere duplication of the essential working parts of an article requires only routine skill in the art. MPEP 2144.04. Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the patches.

In response to Applicant's argue that Smith fails to disclose the narrow release strip, Smith clearly states that the silicone has many patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). Therefore, it would have been obvious to one of ordinary skill in the art to change the adhesive pattern as the specification provides no unforeseen result due to the shape of the silicone release strips.

In response to Applicant's argue that Smith fails to disclose the silicone form of the release strip, Smith clearly states that the silicone has many patterns, wherein the patterns are chosen from discontinuous strips, dots a series of polygons or a wide variety of patterns (Column 3, lines 41 – 46). Therefore, it would have been obvious to one of ordinary skill in the art to

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change the adhesive pattern as the specification provides no unforeseen result due to the shape of the silicone release strips.

In response to Applicant's argument that no weight has been afford to the additional features of the cutting blade and printer in the claim, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The printer is only mentioned in the intended use of the label in claim 19. Therefore, no weight is being given to the limitations of the printer having a feed part and components or the method of using the label roll in combination with a printer. The preamble of the claim is directed towards a linerless label. Slagsvol meets the claim limitations directed towards the label construction in combination with and Smith.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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